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MILLIKEN & COMPANY
920 MILLIKEN RD
PO BOX 1926
SPARTANBURG, SC 29304

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SALVATORE, LYNDA	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 20040219

Application Number: 09/495,257
Filing Date: January 31, 2000
Appellant(s): WORRELL ET AL.

Sara M. Current
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 12th, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief has been amended in view of the Interview Summary of February 17th, 2004. The changes are as follows:

1. Whether claims 8-21 are properly rejected under 35 U.S.C. 112, second paragraph as being indefinite.

2. Whether claims 7-12, and 14-20 are properly rejected under 102 (b) as being anticipated by Rock et al., US 5,547,733.

3. Whether claims 8-12 and14-21 are properly rejected under 35 U.S.C. 102(b)/103(a) as being unpatentable Rock et al., US 5,547,733.

4. Whether claim 13 is properly rejected under 35 U.S.C. 103(a) as being unpatentable over Rock et al., US 5,547,733 as applied to claim 8 above, and further in view of Moore, US T962, 002.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 7-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 5,547,733	Rock et al.	8-1996
US T962002	Moore	9-1977

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claim 8 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 9-21 are further rejected for their dependency on claim 8.

2. Claim 8 recites the limitation of a hairiness value when measured with a Zweigle T690 Hairiness tester. Claim 8 is directed to a sanded elastic fabric having a hairiness value, but fails to set forth what provides for said value.

Ex parte Slob, 157 USPQ 172 states the following with regard to an article claimed by defining property values:

> Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics, thus, expression "a liquefiable substance having a liquefaction temperature from 40°C to about 300°C and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and in effect, recites compositions by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

Thus, claim 8 is indefinite for only reciting the desired hairiness value of the sanded elastic fabric rather than setting forth the chemical and/or structural features that produce the claimed hairiness value.

3. Claims 7-12 and 14-20 are rejected under 102 (b) as being anticipated by Rock et al., US 5,547,733.

Rock et al. discloses a double knit composite fabric having an inner layer comprising a plurality of polyester fibers and an outer layer comprising a mixture of polyester and cotton fibers (Abstract and Column 3, lines 13-20). Rock et al. teaches replacing the polyester of the inner layer with a stretching polyester such as Dupont's LYCRA (i.e., spandex) to give the fabric elasticity (Column 3, lines 14-16). The inner fabric layer comprises between 10 and 60 % by weight of the fabric. The fabric construction is a weft knit, such as two or three end terry with regular plaiting, double terry, and tricot (Column 3, lines 57-59 and Claim 5). With regard to claim 10, a tricot inherently is a warp knit. Even though the fabric layers are separate they are integrated with one another, allowing the composite to function as a single unit (Column 3, lines 51-55). To impart softness, Rock et al. teaches sanding, brushing or napping the surface of the inner fabric to slightly raise the fabric (Column 4, lines 36-41). With regard to the limitation of

having a hairiness value less than about .1, Applicant discloses in the instant specification that conventional sanding results in hairiness values ranging from .125 to .14. The Examiner interprets less than about .1 to mean values +- .1. Thus, the Examiner fails to see a difference in prior art sanded fabric and the instant invention as the end point of .1 is overlapping with the ranges disclosed in the prior art.

With respect to claim 7, the method limitation of abrading the fibers with a micro-finishing film is not given patentable weight at this time since it is not shown that the micro-finishing film produces a substantially different abraded surface over the sanded, brushed or napped surface of the prior art. Recall that Rock et al. fully discloses sanding the surface of the inner fabric to impart softness, which would improve the hand feel as claimed by the applicant.

4. Claims 8-12 and 14-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rock et al., US 5,547,73.

Although the prior art of record does not explicitly teach the claimed hairiness value when measured with a Zweigle T690 Hairiness Tester of .07 or less, it is reasonable to presume that the hairiness value is inherent to the Rock et al., invention. Support for said presumption is found in the use of the like materials (i.e. LYCRA or spandex) and the use of the like methods (i.e. such as abrading the surface of the fabric), which would result in the claimed property. The burden is upon the applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 495

In addition, the presently claimed property of a hairiness value of less than .07 would obviously have been present once the Rock et al. product is provided. *In re Best,* 195 USPQ at 433, footnote 4 (CCPA 1977)

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rock et al., US 5,547,733 in view of Moore, US T962, 002.

Rock et al., fails to disclose Raschel warp knit, however, the patent issued to Moore discloses a Raschel warp knit fabric comprising elastic and non-elastic filaments (Title and Abstract). Moore teaches that a Raschel warp knit structure of elastic and non-elastic yarns produce a two-way stretch fabric (Abstract). Therefore, motivated by the desire to produce a two-way stretch fabric, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the elastic garment of Rock et al. using the Raschel warp knit structure taught by Moore.

(11) Response to Argument

1. Applicant traverses the above 112, 2nd paragraph rejection by arguing that the recitation of structurally quantifying a low level of hairiness using a Zweigle T690 Hairiness tester clearly meets the requirements for 35 USC 112 second paragraph (Brief, section 1, spanning pages 3 and 4).

In response, it is the position of the Examiner that merely reciting an article having a desirable physical property is not enough evidence to patentably distinguish the final product structure over the prior art and the instant invention. It is asserted that the maintained 112, 2nd paragraph rejection is proper as the claims lack the necessary structural, chemical and/or method limitations which would provide said hairiness value. Without said limitations, the claim covers sanded elastic fabrics which are presently known in the art. However, Applicant is attempting to claim a known sanded elastic fabric article by a desirable physical property, which by Applicant's own admission of conventional sanding, does not produce a patentably

distinguishable final product from that of the prior art (see above 102(b) rejection). If Applicant maintains that the instant claims are patentably distinguishable over the prior art because of the claimed hairiness value property, then what are the structural, chemical and/or method limitations, which provide for said property? The invention does not lie in the desired hairiness property, but how to achieve said property. Claims merely setting forth desired physical properties rather then the limitations that provide for said properties are dynamic in scope, in that they encompass past or future materials and/or methods not disclosed of achieving said property. As a result of such dynamic type claims, any sanded fabric presently known or that might be known in the future possessing a hairiness value of less than about .1 would infringe on the instant claims despite the lack of contribution by Applicant for such development. The physical property limitations recited by Applicant represent what Applicant desires to achieve, rather the contribution over the prior which provides for said limitations.

Applicant further argues that the determination of indefiniteness requires analysis of the bounds of the claim when read in light of the specification (Brief, section 1, page 4). However, the Examiner asserts that 1) it is improper to import limitations from the specification into the claims and 2) the Examiner can't analyze the bounds of the claim when the "bounds" are not set forth. In other words, it is impossible for the Examiner to read limitations that don't exist in light of the specification. The Examiner is not maintaining indefiniteness based on terms recited in the claims and defined in the specification. Rather, the Examiner asserts that said claims are indefinite based on the fact that Applicant is claiming a known article having a desirable hairiness property, rather than the structural, chemical, and/or method limitations that provide for said property. As presently recited, the scope of the claim encompasses a fabric having a specific

hairiness value property. However, Applicant discloses that said property results from treating the surface of the fabric with a micro-finishing film. Essentially, Applicant is asking the Examiner to read method limitations from the specification into an article claim having no method limitations. It appears Applicant seeks patent protection for all future sanded fabrics having a hairiness value of less than about .1, but does not want to be limited by the patentably distinguishable features that provides said property. As a result, of claming the fabric by what it is desired to do, rather than by what it *is,* it would be necessary for skilled artisan to perform an experiment with every sanded fabric presently known and yet to be invented and compare the hairiness properties of these fabrics with the instant claims to determine infringement.

Applicant's second traversal is with regard to the indefiniteness of claim 19. Applicant asserts that sanding the fabric in the manner of the invention functions to loosen the fibers in the yarn bundles without undesirably cutting them in the manner of conventional sand paper, and that one of ordinary skill in the art would appreciate the meaning of yarn bundles of loosened fibers to mean a yarn bundle which as at least some of its fiber loosened. (Brief, Section 1, page 4). In response, Applicant's arguments are found persuasive to overcome the 112, 2nd paragraph rejection. As such, the 35 U.S.C. 112 2nd rejection of claim 19 is withdrawn. However, claim 19 is still rejected for being dependent on rejected claim 8 as indefinite under Ex Parte Slob.

In conclusion it is reasserted that the claims as presently recited are indefinite under 35 U.S.C. 112, 2nd paragraph because the metes and bounds are not clearly set forth and for lacking the necessary definiteness which would serve to patently distinguish over the prior art.

2. Applicant traverses the 102 (b) rejections of claims 7-12 and 14-20 as being anticipated by Rock et al., US 5,547,733, on the grounds that Rock et al., does not teach using a micro-

finishing film to treat the surface of the fabric, but uses conventional sanding. The Applicant further asserts that the fabrics of Rock et al., which are sanded in a conventional manner, tend to have a high amount of fuzz and therefore do not meet the hairiness levels of the instant invention. (Brief, section II, page 5). Though Applicant makes no specific arguments with regard to any one claim, it should be noted that the argument regarding the use of a micro-finishing film to treat the surface of the fabric is misplaced for claims 8-12 and 14-20, as independent claim 8 is not limited by the use of a micro-finishing film.

In response to Applicant's argument that Rock et al., does not teach using a micro-finishing film to treat the surface of the fabric, the Examiner agrees. However, with specific regard to claim 7, the Examiner maintains not giving the method limitation of abrading the surface with a micro-finishing film patentable weight. In support of this position, it has been held that while product-by-method claims are limited by and defined by the method; determination of patentability is based on the product itself. The patentability of a product does not depend on the method of production. If the product in the product-by-method claim is the same as or an obvious variant from a product of the prior art, the claim is unpatentable even though the prior art was made by a different method. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden is shifted to the Applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983). As such, since the prior art final product meets the structural limitations of an abraded fabric, the Examiner maintains that the use of a micro-finishing film to abrade the surface of a fabric does not serve to patently distinguish over the prior art of record since no physical distinguishing characteristics

are positively associated with the method. Thus, the product in the product-by-method *is* the same as or an obvious variant from the product of the prior art product.

In response to Applicant's second argument that conventionally sanded fabrics tend to have a high amount of fuzz and therefore do not meet the hairiness levels of the instant invention, Applicant's own disclosure teaches that conventional sanding provides hairiness values of about .1. The Applicant has failed to disclose what the range of less than "about .1" encompasses (See Table 1, Page 11, Applicant's specification). Without such limitations, the Examiner concludes that values +/- .1 meets the limitation of less than about .1.

3. Applicant traverses the rejections of claims 8-12 and 14-21 rejected under 35 U.S.C. 102(b)/103(a) as being unpatentable Rock et al., US 5,547,733 on the assertion the Rock et al., teaches sanding which would provide "high" levels of hairiness rather than the claimed "low" hairiness and that Rock et al., further fails to teach a fabric processed using a micro-finishing film (Brief, Section 4, page 6).

In response to Applicant's argument that Rock et al., produces what the Applicant considers unacceptably "high" hairiness values, the Examiner maintains based on Applicant's own disclosure that conventional sanding provides hairiness values of about .1. Specifically, Applicant discloses hairiness values ranging from .125 to .14. To reiterate, Applicant has failed to disclose what the range of less than "about .1" encompasses (See Table 1, Page 11, Applicant's specification). Without such limitations, the Examiner maintains that conventional sanding would inherently provide values of +/- .1.

To reiterate, although the prior art of record does not explicitly teach the claimed hairiness value when measured with a Zweigle T690 Hairiness Tester of .07 or less, it is

reasonable to presume that the hairiness value is inherent to the Rock et al., invention. Support for said presumption is found in the use of the like materials (i.e. LYCRA or spandex) and the use of the like methods (i.e. such as abrading the surface of the fabric), which would result in the claimed property. The burden is upon the applicant to prove otherwise. *In re Fitzgerald* 205 USPQ 495

In addition, the presently claimed property of a hairiness value of less than .07 would obviously have been present once the Rock et al. product is provided. *In re Best,* 195 USPQ at 433, footnote 4 (CCPA 1977)

In response to Applicant's second argument the Rock et al., fails to teach using a micro-finishing film to abrade the surface, the Examiner respectfully points out that claims 8-12 and 14-21 are not limited by the use of a micro-finishing film to provide the desired hairiness value.

4. Applicant traverses the rejection of claim 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Rock et al., on the grounds by first asserting that claim 13 is allowable over the Rock et al., reference for reasons set forth above. In addition, Applicant argues that Moore teaches an un-sanded Raschel warp knit structure and fails to teach a sanded fabric having the claimed low hairiness values, or the sanding of an elastic fabric with as micro-finishing film (Brief, Section 3, spanning pages 5 and 6).

In response, the Examiner asserts that Moore is relied upon only as a secondary reference to evidence that Raschel warp knitting machines are well known in the art and it would be obvious to one having ordinary skill in the art to use such a machine to form a Raschel knit fabric from elastic and non-elastic filaments.

5. In closing, independent claim 8 and dependent claims 9-21 are indefinite for only reciting the desired hairiness value of the sanded elastic fabric rather than setting forth the chemical and/or structural features that produce the claimed hairiness value. Claims 7-12 and 14-20 are rejected under 102 (b) as being anticipated by Rock et al., US 5,547,73 on the assertion that conventionally sanded fabrics would meet the structural limitations of the inventive elastic fabric. Claims 8-12 and 14-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rock et al., US 5,547,73 on the assertion that the use of like materials and processes would inherently produce the desirable properties of the inventive sanded elastic fabric. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rock et al., US 5,547,733 in view of Moore, US T962, 002 on the assertion that it would have been obvious to one having ordinary skill in the art to employ a Raschel warp knitting machine.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

ls
February 23, 2004

Conferees
Terrel Morris -FM
Deborah Jones

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

MILLIKEN & COMPANY
920 MILLIKEN RD
PO BOX 1926
SPARTANBURG, SC 29304

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